

RECEIVED

FEB 22 2001

OFFICE OF PETITIONS

PATENT

Customer Number 22,852

Attorney Docket No.: 7451.0007-02000

InterTrust Ref. No.: IT-11.2 (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Prior Application of:

Edwin J. Hall, et al.

Prior Serial No.: 09/300,778

Filed: April 27, 1999

For: TECHNIQUES FOR DEFINING, USING
AND MANIPULATING RIGHTS
MANAGEMENT DATA STRUCTURES

Office of Petitions
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

PETITION UNDER 37 CFR 1.53(e)

Applicants respond to the Notice of Improper CPA Filing Under 37 CFR 1.53(d) dated January 8, 2001, with this Petition Under 37 CFR 1.53(e). Applicants respectfully request that the papers previously filed under 37 CFR 1.53(d) be treated as an appropriate filing under 37 CFR 1.53(b) and that the application be accorded a filing date of September 28, 2000.

Applicants suspect that the application was incorrectly treated as a CPA under 1.53(d), rather than a continuation under 1.53(b), due at least in part to our error. On September 28, 2000, Applicants filed with the PTO all the requisites of a complete application under 1.53(b) including, as is shown on the attached copy of the postcard indicating receipt, a specification, an oath or declaration, drawings, and filing fee. Unfortunately, we erroneously requested on the first line of our Transmittal Letter that the application be filed under Rule 1.53(d) instead of 1.53(b). Quite understandably, we received a Notice of Improper CPA Filing under 37 CFR 1.53(d) dated January 8, 2001, since at the time of filing the continuation application we had already paid the issue fee in the parent case. When we telephoned Mr. Fred Silverberg of the

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.

STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIF. 94304

650-849-8600

02/23/2001 LGIBBS

01 FC:122

00000002 09300778

130.00 0P

Adjustment date: 05/30/2001 AXELLEY
02/23/2001 130.00 0P 09300778
01 FC:122 -130.00 0P

Adjustment date: 05/30/2001 AXELLEY
02/23/2001 130.00 0P 09300778
01 FC:122 -130.00 0P

05/30/2001 AXELLEY 00000005 09300778

01 FC:122 130.00 0P
02 FC:122 130.00 0P

Office of Petitions to ask how we should respond to the Notice, he kindly suggested that we file this Petition.

In keeping with Mr. Silverberg's suggestion, Applicants respectfully request that our typographical error be excused and the papers we filed on September 28, 2000, be retrieved from the file wrapper of the parent matter, U.S. Application Ser. No. 09/300,778, now U.S. Patent No. 6,138,119, accepted as a continuation application under 37 CFR 1.53(b), and accorded a filing date of September 28, 2000. We submit that the papers as filed on September 28, 2000, satisfy all the requirements for a continuation application under 37 CFR 1.53(b). We further submit that Applicants' clear intent to file a continuation application under 1.53(b) is demonstrated in numerous ways including, but not limited to, by: 1) our language on the acknowledgment postcard; 2) the language in ¶8 of the Transmittal Letter reciting that "this application is a continuation of copending application Serial No. 09/30,778, filed April 27, 1999,..."; and 3) our filing the application after payment of the issue fee in the parent, but prior to issuance. To facilitate review of this request, we submit a duplicate copy of the as-filed papers as well as a copy of the stamped postcard indicating receipt by the PTO.

We enclose a check for \$130.00 to cover the cost of the petition as well as a copy of the Notice of Improper CPA Filing Under 37 CFR 1.53(d). Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916. If any additional information is needed to approve this Petition, please feel free to contact the undersigned at (650) 849-6621.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Linda J. Thayer
Reg. No. 45,681

Dated: February 21, 2001

RECEIVED

FEB 22 2001

OFFICE OF PETITIONS

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIF. 94304
650-849-6600

(PI-L-8T

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Edwin J. Hall, et al.

Serial No.: 09/300,778

Group Art Unit: 2771

Filed: April 27, 1999

Examiner: W. Amsbury

For: **TECHNIQUES FOR DEFINING, USING AND MANIPULATING RIGHTS
MANAGEMENT DATA STRUCTURES**

-
1. Transmittal Letter (3 pages)
 2. Continuation Application (92 pages, including 14 pages of informal drawings and cover sheet)
 3. Preliminary Amendment (24 pages)
 4. Original Declaration and Power of Attorney (2 pages)
 5. Revocation of Original Power of Attorney and Grant of New Power of Attorney (2 pages)
 6. Submission of Formal Drawings (1 page)
 7. Formal Drawings (14 pages)
 8. Check for \$1,944.00

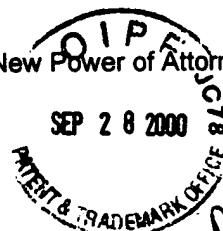
SEP 28 2000

Dated September 28, 2000

Docket No.: 07451.0007-02000

Attorney: Linda J. Thayer

Mail Drop: CA



Phis
a-jac
U.S.

Palo Alto file copy

CPI/LJT

**PLEASE ACCORD THIS NEW U.S. PATENT APPLICATION A SERIAL
NUMBER AND FILING DATE**

New U.S. Application for: **TECHNIQUES FOR DEFINING, USING AND
MANIPULATING RIGHTS MANAGEMENT DATA STRUCTURES**

Inventors: **Edwin J. Hall et al.**

SERIAL NO.:
FILING DATE:

Dated: September 28, 2000

Case Ref: 07451.0007-02000

Attorney: Linda J. Thayer, Mail Drop: CA



Copy Retained

in Washington DC

on 10/7/00

no serial number
✓-LR

12/2

RECEIVED
Nixon & Vanderhye P.C. (12/95)

**RULE 63 (37 C.F.R. 1.63)
DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION**

FEB 22 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF PETITIONS

I, as a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name, and I believe I am the original first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

TECHNIQUES FOR DEFINING, USING AND MANIPULATING RIGHTS MANAGEMENT DATA STRUCTURES

the specification of which (check applicable box(s)):

☐ is attached hereto
☒ was filed on 25 February 1997 as U.S. Application Serial No. _____ (Atty Dkt. No. 895-70).
☐ was filed as PCT international application No. _____ on _____
and (if applicable to U.S. or PCT application) was amended on _____

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with 37 C.F.R. 1.56. I hereby claim foreign priority benefits under 35 U.S.C. 119/365 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed or, if no priority is claimed, before the filing date of this application:

Prior Foreign Application(s):

| | | |
|--------------------|---------|----------------------|
| Application Number | Country | Day/Month/Year Filed |
|--------------------|---------|----------------------|

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below.

| | |
|--------------------|----------------------|
| Application Number | Day/Month/Year Filed |
|--------------------|----------------------|

I hereby claim the benefit under 35 U.S.C. 120/365 of all prior United States and PCT international applications listed above or below and, insofar as the subject matter of each of the claims of this application is not disclosed in such prior applications in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose material information as defined in 37 C.F.R. 1.56 which occurred between the filing date of the prior applications and the national or PCT international filing date of this application:

Prior U.S./PCT Application(s):

| | | |
|------------------------|----------------------|---|
| Application Serial No. | Day/Month/Year Filed | Status: patented, pending, abandoned |
|------------------------|----------------------|---|

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. And I hereby appoint **NIXON & VANDERHYE P.C., 1100 North Glebe Rd., 8th Floor, Arlington, VA 22201-4714, telephone number (703) 816-4000** (to whom all communications are to be directed), and the following attorneys thereof (of the same address) individually and collectively my attorneys to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith and with the resulting patent: Arthur R. Crawford, 25327; Larry S. Nixon, 25640; Robert A. Vanderhye, 27076; James T. Hosmer, 30184; Robert W. Faris, 31352; Richard G. Besha, 22770; Mark E. Nusbaum, 32348; Michael J. Keenan, 32106; Bryan H. Davidson, 30251; Stanley C. Spooner, 27393; Leonard C. Mitchard, 29009; Duane M. Byers, 33363; Paul J. Henon, 33626; Jeffry H. Nelson, 30481; John R. Lastova, 33149; H. Warren Burnam, Jr., 29366; Thomas E. Byrne, 32205; Mary J. Wilson, 32955; J. Scott Davidson, 33489; Alan M. Kagen, 36178; William J. Griffin, 31260; Robert A. Molan, 29834.

| | |
|--|----------------------------|
| 1. Inventor's Signature: <u>Edwin J. Hall</u> | Date: <u>2-28-97</u> |
| Inventor: Edwin J. Hall | U.S.A. |
| (first) MI (last) | (citizenship) |
| Residence: (city) San Jose | (state/country) California |
| Post Office Address: 5035 Country Lane, San Jose, California | |
| (Zip Code) 95129 | |
| 2. Inventor's Signature: <u>Victor H. Shear</u> | Date: <u>3/3/97</u> |
| Inventor: Victor H. Shear | U.S. |
| (first) MI (last) | (citizenship) |
| Residence: (city) Bethesda | (state/country) Maryland |
| Post Office Address: 5203 Battery Lane, Bethesda, Maryland | |
| (Zip Code) 20814 | |
| 3. Inventor's Signature: <u>Luke S. Tomasello</u> | Date: <u>3/3/97</u> |
| Inventor: Luke S. Tomasello | U.S.A. |
| (first) MI (last) | (citizenship) |
| Residence: (city) San Jose | (state/country) California |
| Post Office Address: 204 Copco Lane, San Jose, California | |
| (Zip Code) 95123 | |

FOR ADDITIONAL INVENTORS, check box ☒ and attach sheet with same information and signature and date for each.

4. Inventor's Signature: *David M. Van Wie* Date: 2/28/97
Inventor: David M. Van Wie U.S.
(first) (last) (citizenship)
Residence: (city) Sunnyvale (state/country) California
Post Office Address: 1250 Lakeside Drive, Sunnyvale, California
(Zip Code) 94086
5. Inventor's Signature: *Robert P. Weber* Date: 3/3/97
Inventor: Robert P. Weber U.S.A.
(first) (last) (citizenship)
Residence: (city) Menlo Park (state/country) California
Post Office Address: 215 Waverley Street, #4
(Zip Code) 94025
6. Inventor's Signature: *Kim Worsencroft* Date: 2/28/97
Inventor: Kim MI Worsencroft U.S.A.
(first) (last) (citizenship)
Residence: (city) Los Gatos (state/country) California
Post Office Address: 81 Reservoir Road, Los Gatos, California
(Zip Code) 95032
7. Inventor's Signature: *Xuejun XU* Date: 3/3/97
Inventor: Xuejun MI XU Peoples Republic of China
(first) (last) (citizenship)
Residence: (city) Fremont (state/country) California
Post Office Address: 5839 Northland Terrace, Fremont, California
(Zip Code) 94555

FOR ADDITIONAL INVENTORS, check box ☐ and attach sheet with same information and signature and date for each.

RECEIVED
FEB 22 2001
OFFICE OF PETITIONS

PATENT
Attorney Docket No. 07451.0007-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------|---|----------------------|
| In re Application of |) | |
| |) | |
| Edwin J. HALL et al. |) | |
| |) | |
| Serial No. 08/805,804 |) | Group Art Unit: 2771 |
| |) | |
| Filed: February 25, 1997 |) | Examiner: W. Amsbury |
| |) | |
| For: TECHNIQUES FOR DEFINING, |) | |
| USING AND MANIPULATING |) | |
| RIGHTS MANAGEMENT |) | |
| DATA STRUCTURES |) | |
| |) | |

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REVOCATION OF ORIGINAL POWER OF ATTORNEY
AND GRANT OF NEW POWER OF ATTORNEY

InterTrust Technologies Corporation ("assignee"), a California corporation having a place of business at 460 Oakmead Parkway, Sunnyvale, CA 94086, certifies that to the best of assignee's knowledge and belief it is the assignee of the entire right, title, and interest in and to the above-referenced patent application and represents that the undersigned is a representative authorized and empowered to sign on behalf of the assignee.

Assignee has reviewed the assignment document that evidences the placement of title in the assignee, a true and correct copy of which is attached hereto, and understands and believes that the assignment document has been submitted for recordation in the U.S. Patent and Trademark Office.

Pursuant to 37 C.F.R. § 1.36 and 3.71, the assignee hereby revokes all powers of attorney previously given and appoints **FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.**, Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630; Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsvold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No. 25,857;

Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zotter, Reg. No. 27,680; Dennis P. O'Reilly, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewis, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; John C. Paul, Reg. No. 30,413; Roger D. Taylor, Reg. No. 28,992; David M. Kelly, Reg. No. 30,953; Kenneth J. Meyers, Reg. No. 25,146; Carol P. Einaudi, Reg. No. 32,220; Walter Y. Boyd, Jr., Reg. No. 31,738; Steven M. Anzalone, Reg. No. 32,095; Jean B. Fordis, Reg. No. 32,984; Barbara C. McCurdy, Reg. No. 32,120; James K. Hammond, Reg. No. 31,964; Richard V. Burgujian, Reg. No. 31,744; J. Michael Jakes, Reg. No. 32,824; Dirk D. Thomas, Reg. No. 32,600; Thomas W. Banks, Reg. No. 32,719; Christopher P. Isaac, Reg. No. 32,616; Bryan C. Diner, Reg. No. 32,409; M. Paul Barker, Reg. No. 32,013; Andrew Chanhon Sonu, Reg. No. 33,457; David S. Forman, Reg. No. 33,694; Vincent P. Kovalick, Reg. No. 32,867; James W. Edmondson, Reg. No. 33,871; Michael R. McGurk, Reg. No. 32,045; Joann M. Neth, Reg. No. 36,363; Gerson S. Panitch, Reg. No. 33,751; Cheri M. Taylor, Reg. No. 33,216; Charles E. Van Horn, Reg. No. 40,266; Linda A. Wadler, Reg. No. 33,218; David L. Clark, Reg. 37,082; and **INTERTRUST TECHNOLOGIES CORPORATION**, Edmund J. Fish, Reg. No. 38,879 with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

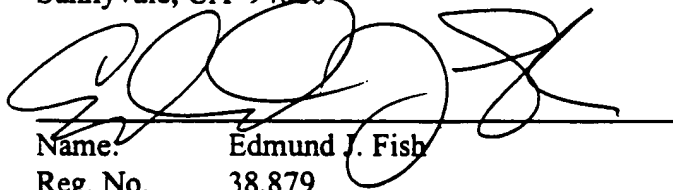
Pursuant to 37 C.F.R. §3.71, the assignee hereby states that prosecution of the above-referenced patent application is to be conducted to the exclusion of the inventors.

Please address all correspondence to **FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER**, L.L.P. 1300 I Street, N.W., Washington, D.C. 20005, Telephone No. (202) 408-4000.

Assignee of Interest

INTERTRUST TECHNOLOGIES CORPORATION
460 Oakmead Parkway
Sunnyvale, CA 94086

Dated: 12/16/88


Name: Edmund J. Fish
Reg. No. 38,879
Title: Executive Vice President and
General Counsel

THIS PAGE BLANK (REPTD)